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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,999	12/22/2005	Marc Riemenschnitter	RO0989US (#90568)	1652

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D Peter Hochberg Co
The Baker Building-6th Floor
1940 East 6th Street
Cleveland, OH 44114-2294

EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3772

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04/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,999	Applicant(s) RIEMENSCHNITTER, MARC	
	Examiner Kim M. Lewis	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/21/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-54 is/are allowed.
- 6) ☐ Claim(s) 32-44 is/are rejected.
- 7) ☒ Claim(s) 45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 1/21/10 has been received and made of record. As requested, claims 45-54 have been newly added. Claims 32-54 are pending in the instant application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by WO93/06144 ("Gangadharan").

As regards claims 32-38, Gangadharan discloses adhesive products capable of use with medical patches or transdermal therapeutic systems (see page 1, lines 5-15). The adhesive comprises a moisture activated adhesive composition and a hydrophobic adhesive polymer core (psa polymer component), wherein the psa component can be a polyacrylate (see page 2, lines 21-29) and at least one component, such as, polyethers and acid anhydrides including acids salts of acid anhydrides such as methylvinyl ether/maleic acid copolymers (see page 3, line 21- page 4, line 4) or a cellulose derivative such as carboxymethyl cellulose (see page 3, lines 31-33). Applicant should

Art Unit: 3772

also note that the disclosure of the adhesive being in the form of multilayer particulate on page 1, line 38-page 2, line 1.

As regards claim 39, note the disclosure of both controlling moisture and a dried product on page 4, line 35- page 5, line 3.

As regards claims 41-43, note the rejection of claim 32 above, and page 5, lines 9-10, which discloses a polar solvent such as water.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan in view of U.S. Patent Application Publication No. 2004/0068036 ("Halliday").

Art Unit: 3772

7. As regards claim 44, Gangadharan discloses the adhesive composition of claim 44, but does not disclose the use of solvents, such as, hexane and ethyl acetate.

Halliday, however, teaches that it known to coat compositions, wherein the coatings can be provided in a carrier liquid, such as the solvents hexane, ethyl acetate and water (paras. 0220, 0221 and 0224).

Thus, it would have been obvious to one having ordinary skill in the art to substitute the water solvent of Gangadharan for one of the disclosed solvents of Halliday, such as hexane or ethyl acetate, and to achieve a reasonable expectation of success, since Halliday discloses the equivalence of the solvents water, hexane and ethyl acetate, with the distinctive choice being the environment.

8. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan.

As regards claim 40, Gangadharan discloses controlling moisture and a dried product on page 4, line 35- page 5, line 3. Gangadharan fails to teach that the product is a dried film. However, the examiner contends that it would have been obvious to one having ordinary skill in the art to provide the adhesive in any form including a film depending upon the intended use. Applicant should note that varying the form/shape of the adhesive will allow the adhesive to be used differently (*i.e.*, in differently body parts, on different elements, *etc.*).

Response to Arguments

9. Applicant's arguments filed 1/21/10 have been fully considered but they are not persuasive. With respect to claims 32-44, Applicants argues the broad statement that "Applicants respectfully disagree with the Examiner's conclusion and submit that the present invention is patentably distinct from the invention disclosed in the cited reference." ***However, no specific evidence of how the prior art differs from the instantly claimed invention is presented.*** Thus, the examiner maintains her rejection of the claims. Applicant should note that the incorporation of allowable subject matter into new claims does not impact the previously rejected claims unless they are amendment to include allowable subject matter or made to depend from an allowable claim.

Allowable Subject Matter

10. Claims 45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 47-54 are allowed.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3772

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Monday to Wednesday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/
Primary Examiner
Art Unit 3772

kml
April 13, 2010